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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,957	02/26/2004	Christopher W. Blackburn	1842.023US1	5774
70648 7590 06/03/2010 SCHWEGMAN, LUNDBERG & WOESSNER/WMS GAMING P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER DEODHAR, OMKAR A				
ART UNIT 3714		PAPER NUMBER		
NOTIFICATION DATE 06/03/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@slwip.com
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Office Action Summary

Application No.

10/789,957

Applicant(s)

BLACKBURN ET AL.

Examiner

OMKAR A. DEODHAR

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

In view of the Appeal Brief filed on 10/13/2009, and Office guidance concerning computer-readable media in light of *Bilski*, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

Response to Arguments

Claims drawn to a computer-readable medium may not comport with current Office guidance concerning *Bilski*. As such, Examiner is issuing a section 101 rejection as set forth more fully below.

Additionally, Applicant's arguments have been considered but are moot in view of the new grounds of rejection. Specifically, Examiner agrees that Gatto's limited mention of discovery services and software searching for updates (Gatto, Col. 13. Lines 33-56) is

insufficient to render obvious the claimed limitation requiring determining, by a discovery agent, if the progressive service is authentic and authorized.

However, after further search, prior art to Lagosanto (US 7,003,663) was discovered. Lagosanto renders the claimed invention obvious because Lagosanto teaches validating information prior to forming and publishing or releasing a service bundle. This means that Gatto's discovery agent & software would validate or authenticate service information prior to its publication. See Lagosanto Col. 6. Lines 40-51.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 28-46 are directed to non-statutory subject matter. These claims are drawn towards computer-readable media encompassing signals *per se*. Claims drawn to computer readable media covering both transitory and non-transitory embodiments **may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. 101 by adding the limitation "non-transitory"** to the claim.

Such an amendment would typically *not* raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals *per se*. The limited situations in which such an amendment could raise issues of new matter occur, for example, when the specification does not support a non-transitory embodiment because a signal *per se* is the only viable embodiment such that the amended claim is impermissibly broadened beyond the supporting disclosure.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto (US 6,916,247) in view of Tarantino (US 6,605,001) in further view of Lagosanto (US 7,003,663).

Claims 1, 13, 20, 28 & 40: Gatto discloses a method, gaming network and computer readable media for providing a gaming service in a gaming network (Abstract, Figures 5/8-11, Col.2. Lines 37-45). Although Gatto discloses game services and network architecture for monitoring and controlling gaming devices, (*See* the cited sections), Gatto does not explicitly disclose a "progressive service". A "progressive service" is interpreted as a gaming service associated with a type of progressive game (e.g., a plurality of players contributing to a common pool that is paid out at a gaming machine upon a triggering event.)

In a related invention drawn towards linked gaming devices, Tarantino teaches progressive gaming services on a gaming network. See Tarantino, Abstract & Figure 3. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to extend Tarantino's teaching of progressive gaming services to Gatto's system for the purpose of enabling player tournaments in which players would not only compete for the same progressive jackpots, but actually compete against each other in real time. (See Tarantino Col. 1. Lines 39-50) Furthermore, as evidenced by Tarantino's disclosure, progressive gaming is readily recognized in the art & is popular in casinos. As such, implementing a progressive service in Gatto's system would yield predictable & expected results.

Gatto discloses publishing services & a device that requests a location of a service from gaming machines coupled to the network. See Figure 19: "Broadcast Availability"; Col. 13. Lines 64-67 & Col. 15. Lines 49-56 teaching publication of web services & software that searches for & binds to offered services. The networked gaming machines interact with network services using, for instance, UDDI technology.

Regarding the following limitations, "wherein the progressive service provides information regarding a progressive wagering game to a plurality of gaming machines operable to participate in a progressive wagering game, and wherein in response to a wager at one of the plurality of gaming machines the gaming machine depicts indicia representative of a randomly selected outcome of a wagering game," Tarantino discloses progressive gaming and the cited portions disclose wagering games that have randomly determined outcomes displayed on a screen. Gatto shows such a screen displaying outcomes in Fig. 3.

While Gatto in view of Tarantino discloses the invention substantially as claimed including progressive services, Gatto's discovery services and software searching for updates (Gatto, Col. 13. Lines 33-56) does not disclose the following claim limitations, "determining by the discovery agent if the progressive service is authentic and authorized; in response to determining that the progressive service is authentic and authorized, publishing the service information to a service repository to make the progressive service available on the gaming network."

The preceding limitations are interpreted as requiring service authorization as a prerequisite to service publication. In a related invention, Lagosanto teaches validating

information prior to forming a service bundle that is to be published or released. See Lagosanto Col. 6. Lines 40-51.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify Gatto in view of Tarantino's progressive gaming with Lagosanto's teaching of validating information prior to forming a service bundle that is to be published or released. As described above, in Col. 15, Lines 54-56, Gatto teaches publication of web services, UDDI, and software searching for, and binding to said services. Gatto is thus amenable to being modified such that discovered applications or services are validated prior to being published or released. This yields the predictable results of precluding malicious code from being installed, let alone even published on the network. Changes to the prior art utilizing known elements yielding predictable results are considered obvious.

Gatto further discloses receiving by the discovery agent a request for the location of the service from a gaming machine coupled to the network (Figures 19 & 20), where examiner notes that the steps "Broadcast Availability," "Bind to Device" and "Communication" are interpreted as teaching this limitation. Gatto additionally discloses, returning the service information for the gaming management service to the gaming machine, sending a request to register the machine with the service, and determining if the machine is authorized (Gatto teaches registering the gaming machine with the service, (Fig. 20 & Col. 14. Lines 9-32), where it is noted that the server (112) registers (or subscribes) with specialized devices (gaming machines). The gaming machine would have to be authorized for this registration to be successful.);

and in response to determining that the machine is authorized to use the service, processing service requests between the gaming machine and the service, (Gatto, Figure 19; Col.

15. Lines 45-49; Col. 15. Lines 57-60; Col. 16. Lines 7-11; Col. 18. Lines 4-6) to provide the configuration updates the gaming machine.

Claims 2, 3, 4, 14, 15, 21, 29-31, 41, 42: Gatto discloses that the game management service is a web service, (Col. 15. Lines 49-56.) Gatto explicitly teaches the claimed "Web Services Description Language" (WDSL). See Col. 15. Lines 45-53.

Claims 5-12, 16-19, 22-27, 32-39, 43-46: When modified by Tarantino's progressive service, Gatto's service requests would be directed towards progressive services. The cited portions to Tarantino teach that progressive services include games, wagers, jackpots, outcomes and award amounts. Thus, Gatto's update and configuration system would include a progressive service and its features. Respective networked machines would be notified of updates, outcomes and results. Also, refer to the citations provided with respect to claim 1 & the extensive disclosure of network services in Gatto, Col. 15. Lines 33-67 & Col. 16. Lines 1-42.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMKAR A. DEODHAR whose telephone number is (571)272-1647. The examiner can normally be reached on M-F: 8AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Omkar Deodhar/

/Peter D. Vo/
Supervisory Patent Examiner, Art Unit 3714